



GOVERNMENT OF PUERTO RICO
DEPARTMENT OF STATE



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SUBJECT MATTER
MARK

Office Action



CLASS
FILING NUMBER
FILING DATE
APPLICANT

028
248789-28-0
July 20th, 2022
DECATHLON

To whom it may concern:

In order to proceed with the examination of the said mark Applicant must submit the following information:

- ☒ 1. Clearly state the goods and/or services in connection with the mark as used or intended to be used in commerce in Puerto Rico. This applies if the Applicant customized the selection of goods or services.

The Application in reference includes a broad and indefinite description of the goods and/or services in which the trademark will be used. A written application must specify the particular goods and/or services on or in connection with which the applicant uses, or has a bona fide intention to use, the mark in commerce. To "specify" means to name in an explicit manner. The identification should set forth common names, using terminology that is generally understood. The identification of goods and/or services must be specific, definite, clear, accurate, and concise. *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 1 USPQ2d 1296 (TTAB 1986), rev'd on other grounds, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987); *The Procter & Gamble Co. v. Economics Laboratory, Inc.*, 175 USPQ 505 (TTAB 1972), modified without opinion, 498 F.2d 1406, 181 USPQ 722 (C.C.P.A. 1974).

Applicant identifies and classifies the goods and/or services as follows:

- “Games, toys; gymnastic and sporting articles (except clothing, footwear and mats), nets for sports; game area separator; elbow pads, knee guards (sports articles); wristbands for playing sports, fishing articles, skis, coverings for skis, brakes for skis, ski bindings, edges for skis, ski poles, snowboards, snow surf boards, bobsleighs, snowshoes (sports articles), snowboards (snow surf boards), snowboard bindings, covers for snowboards; climbing walls; climbing harnesses; climbing holds (sports articles); building blocks (toys); hang gliders, paragliders, kites, ice skates, snowshoes (sports articles), kites; kite reels; balls for games; sailboards; surf boards without automotive power; boards used in the practice of water sports; breathing tubes; small balls, balls, nets for sports; skis, water skis, ski edges, ski bindings; flippers for swimming; swimming pools (sports or play articles); waterslides for swimming pools; swings, swimming buoys, snorkels, roller-skates, skateboards, scooters, footballs, balls for American football, rugby balls, basket balls, volleyballs, handballs, bags for balls, nets for balls, push carts for balls; balls, balls for baseball; nets for sports; hockey sticks, hockey pucks, bat for baseball, cricket bats; tees for baseball, tees for rugby; volley-ball aiming marks; goals, mini goals, football goals, hockey goals, covers for goals, rugby posts, basketball baskets, basketball backboards, posts and base plates for basketball, posts for volley-ball, fastenings for posts, nets for restricting circles for basketball, boundary markers for playing fields for team sports, tackle bags for rugby, grips, baseball bases; training accessories for sports especially hoops, slalom cones, slalom marker poles, blocks and markers for blocks, wall bars; physical rehabilitation apparatus and machines for physical exercises (appliances for gymnastics), abdominal boards, stationary exercise bicycles, chest expanders, sporting articles for golf, golf bag trolleys, divot repair tools (golf accessories), golf clubs, golf gloves, golf bags with or without wheels, balls, golf balls, nets for sport, golf products and accessories, sporting articles for billiard games, pétanque balls, playing balls, shuffleboard (games), archery implements; bows for archery, darts, arrows, targets (sporting goods), skittles, catapults (sports article), strings for rackets, guts for rackets, frames for rackets, handles for rackets, rackets; balls for games; table tennis” in International Class 028.

The wording in the identification of goods and/or services needs clarification because it is too broad and could include goods and/or services classified in other international classes. Applicant must clarify the identification of goods and/or to specify the nature of the goods as well as their main purpose and their particular field of use or channels of trade. The applicant may aid in clarifying the indefinite term by following the indefinite subject matter with “namely, [specify goods and/or services by generic or common commercial name and field of use].” Any modification to this wording must identify goods and/or services in properly classified in the original International Class specified in the application for these goods and/or services.

Applicant may substitute the following wording:

- **“Games, namely, board games, darts, bowls, pool table; toys, namely, toy vehicles, learning game for children, playmat; gymnastic and sporting articles, namely, balls for sports, carpet; nets for sports; game area separator being nets for sports; elbow pads for athletic use; knee guards for athletic use; wristbands being wrist guards for playing sports; fishing articles, namely, fishing poles; skis; coverings for skis being bags specially adapted for holding skis; brakes for skis; ski bindings; edges for skis; ski poles; snowboards; snow surf boards; bobsleighs; snowshoes; snowboard bindings; covers for snowboards being bags specially adapted for holding snowboards; artificial climbing walls; climbing**

harnesses; climbing holds for artificial climbing walls; toy building blocks; hang gliders; paragliders; kites; ice skates; kites; kite reels; balls for games; sailboards; surf boards without automotive power; boards used in the practice of water sports; small balls for sports; balls for sports; nets for sports; water skis; flippers for swimming; play swimming pools; waterslides for play swimming pools; swings; roller-skates; skateboards; toy scooters; footballs; balls for American football; rugby balls; basket balls; volleyballs; handballs; bags adapted for holding sports balls; basketball net; balls for sports; balls for baseball; hockey sticks; hockey pucks; bat for baseball; cricket bats; tees for baseball; tees for rugby; volley-ball aiming marks; goals for hockey; mini goals for soccer; football goals; hockey goals; fitted covers for hockey goals; rugby goal posts; basketball baskets; basketball backboards; posts to be affixed to nets for basketball; posts for volley-ball nets; fastenings being structural parts for basketball net posts; nets for basketball; boundary markers for playing fields for team sports, namely, soccer; tackle bags for rugby; grips for gymnastics; baseball bases; training accessories for sports, namely, basketball hoops; slalom cones for skiing; slalom marker poles for skiing; blocks and markers for blocks for track and field; wall bars for gymnastics; machines for physical exercises, namely, treadmill, weight bench; abdominal boards being physical fitness equipment; stationary exercise bicycles; chest expanders; sporting articles for golf, namely, golf balls; golf bag trolleys; divot repair tools being golf accessories; golf clubs; golf gloves; golf bags with or without wheels; golf balls; golf products and accessories, namely, golf putters; sporting articles for billiard games, namely, billiard cues; pétanque balls; playing balls for basketball, soccer; shuffleboard game playing equipment; archery implements; bows for archery; darts; arrows; targets; skittles; catapults for playing type of sport played using catapults; strings for rackets; guts for rackets; frames for rackets; handles for rackets; rackets for tennis, badminton, ping-pong; balls for games; table tennis articles, namely, rackets, balls, nets” in International Class 028; if accurate.

Be advised that this amendment is illustrative and not exhaustive.

The Applicant is referred to the International Classification of Goods and Services under the Nice Agreement provided by the World Intellectual Property Organization for assistance in describing the specific goods in relation to which the Applicant uses the mark in commerce. For a list of the latest Nice Classification of goods you can access the following website:

<http://www.wipo.int/classifications/nivilo/nice/index.htm?lang=EN>

Please note that, while an application may be amended to clarify or limit the identification of services, adding to or broadening the scope of the services is not permitted. Therefore, applicant may not amend the identification to include any services that are not within the scope of the services set forth in the present identification.

- ☐ 2. Provide a drawing of the mark as used or as intended to be used in commerce in Puerto Rico.
- ☐ 3. Provide a detailed description of the mark as used or as intended to be used in commerce in Puerto Rico.
- ☐ 4. Provide a specimen that shows the mark in connection with the goods or services identified in your application.
- ☐ 5. Applicant must disclaim those terms or components of the mark which are not susceptible of exclusive appropriation.

- ☐ 6. The registration for the applied mark is refused on the following grounds:
- ☐ 7. Other.

According to Rule 27 of Puerto Rico's Trademark Rules of Procedure, if the PRTTO does not receive a response to the abovementioned remarks within ninety (90) days, the Application shall be considered abandoned.

Note: Please refer to the name of the Examining Attorney. The office action response shall be filed online at <https://prtmfiling.f1hst.com/>. Please select "RESPUESTA A NOTIFICACION" from the dropdown menu. The cost of said filing is \$15.00. If any questions should arise, you can contact the Examining Attorney at jtorres@estado.pr.gov or marcas@estado.gobierno.pr

Cordially,

A handwritten signature in blue ink, appearing to read "José M. Torres".

José M. Torres, Esq.
Examining Attorney
Puerto Rico Trademark Office